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NO. 191 P. 8

Appl. No. 09/846,490
Amch. dated November 7, 2003
Reply to Office Action of July 7, 2003

REMARKS/ARGUMENTS

No amendments have been made to the claims or the specification. (Claims 1-36 and 39 were previously cancelled.) Claims 37, 38, and 40-55 remain pending in the application. Applicants respectfully request reexamination and reconsideration of the application in view of the following remarks.

As an initial matter, Applicants note that the listings of prior art submitted in three Information Disclosure Statements filed on March 8, 2002, January 10, 2003, and May 8, 2003 are still outstanding. Applicants request that the art cited in those three Information Disclosure Statements be considered and the three listings of prior art be initial and return.

Claims 37, 38, and 40-55 have been rejected under statutory-type double-patenting in view of claims 1-69 of U.S. Patent No. 5,476,211 to Khandros (hereinafter the "Khandros patent"). Applicants respectfully traverse this rejection.

A statutory double patenting rejection is proper only if the claims of the instant application and claims of the Khandros patent are directed to "identical subject matter." (MPEP § 804, pg. 800-20.) As discussed below, there are clear differences in the claims of the instant application and the claims in the Khandros patent. Indeed, the Office Action describes the claims in this application and the Khandros patent as directed to "common subject matter"—not identical subject matter. Therefore, the rejection based on statutory double patenting should be withdrawn.

Claims 37, 38, and 40-55 have been rejected under the judicially created doctrine of obvious-type double patenting also in view of claims 1-69 of the Khandros patent. Applicants respectfully traverse this rejection.

Independent claim 37 of the instant application recites steps in which a tip structure is formed in openings in a masking material, but the claims of the Khandros patent do not include such a requirement. There is thus a clear difference between independent claim 37 (and its dependent claims) of this application and the claims of the Khandros patent.

Independent claim 44 of this application includes the steps of fabricating a tip structure on a sacrificial substrate, joining the tip structure to a contact structure, and releasing the tip structure from the sacrificial substrate. In contrast, the claims of the Khandros patent recite bonding a wire to both a terminal of an electronic component and a sacrificial member, which is

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eventually eliminated. There is thus a clear difference between independent 44 (and its dependent claims) of this application and the claims of the Khandros patent.

There is no reason—and indeed no reason is given in the Office Action—for a person of ordinary skill to conclude that the foregoing differences are obvious. (See MPEP § 804, pg. 800-22.) Therefore, the rejection under the judicially created doctrine of obvious-type double patenting should also be withdrawn.

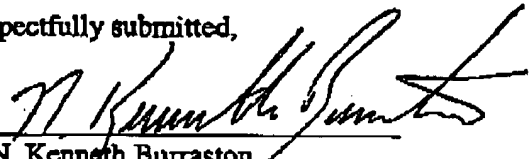
Applicants note that a Terminal Disclaimer has already been filed in this application with regard to U.S. Patent No. 5,864,946.

In view of the foregoing, Applicants submit that all of the claims are allowable and the application is in condition for allowance. If the Examiner believes that a discussion with Applicants' attorney would be helpful, the Examiner is invited to contact the undersigned at (801) 536-6763.

Respectfully submitted,

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